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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Mark A. Ritchart

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6087

7590 10/28/2009
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EXAMINER

FOREMAN, JONATHAN M

ART UNIT

PAPER NUMBER

3736

MAIL DATE

DELIVERY MODE

10/28/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/734,787	Applicant(s) RITCHART ET AL.	
	Examiner JONATHAN ML FOREMAN	Art Unit 3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17, 18, 21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17, 18, 21 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/6/09</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 10/6/09 has been entered.

Information Disclosure Statement

2. The information disclosure statement filed 10/6/09 complies with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609. It has been placed in the application file, and the information referred to therein has been considered by the examiner as to the merits.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 2,198,319 to Silverman in view of U.S. Patent No. 5,462,062 to Rubinstein et al.

In reference to claims 17 and 18, Silverman discloses a method including piercing tissue with an instrument comprising an outer hollow cannula (10) and an inner member (14) having a distal end portion disposed within the hollow cannula; positioning the hollow cannula within the tissue at

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a desired tissue site (Col. 2, lines 4 – 6); actuating a first mechanism (15) associated with the instrument to move the distal end portion of the inner member distally (Col. 2, lines 6 – 9), relative to the outer cannula, so that the distal end portion expands radially and engages a tissue sample to be extracted (Col. 2, lines 9 – 14); actuating a second mechanism (12) associated with the instrument to move the outer hollow cannula distally to retract the distal end portion (Col. 2, lines 14 – 19); and withdrawing the instrument and tissue sample from the tissue (Col. 2, lines 21 – 23). Silverman discloses the inner member being a needle and grasping a tissue sample with the distal end of the inner member (Col. 2, lines 16 - 18). However, Silverman fails to disclose using a plurality of hooked extractors associated with the distal end of the inner member. Rubinstein et al. discloses a method of extracting a tissue sample including the use of a pair of sharp-edged blades (44a, 44b) attached to hinges (42a, 42b) at opposite edges on the interior of a biopsy needle (Col. 3, lines 8 - 11). The inclusion of such a blade and hinge to each portion of the inner member disclosed by Silverman would form a pair of hooked extractors. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the distal end of the needle disclosed by Silverman to include a pair of sharp-edged blades attached to hinges as taught by Rubinstein et al. in order to aid in severing the biopsy and retaining the biopsy in place as the inner member is removed from the patient (Col. 3, lines 11 – 17).

4. Claim 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 2,198,319 to Silverman in view of U.S. Patent No. 5,462,062 to Rubinstein et al. as applied above, and further in view of U.S. Patent No. 5,476,101 to Schramm et al.

In reference to claims 21 and 22, Silverman in view of Rubinstein et al. disclose manually actuating the first and second mechanisms. Schramm et al. teach a biopsy apparatus having a first (55) and second (56) spring element to store energy to drive an inner and outer cannula (Col. 6, lines

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9 – 16). It would have been obvious to one having ordinary skill in the art to modify the device as disclosed by Silverman in view of Rubinstein et al. to include a first and second spring element to store energy to drive the outer hollow cannula and the inner member to allow for a more precise automated sampling procedure. Furthermore, the replacement of a manual operation with an automatic operation is a design consideration within the skill of the art. *In re Venner*, 262, F.2d 91, 120 USPQ 192 (CCPA1955).

Response to Arguments

5. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JONATHAN ML FOREMAN whose telephone number is (571)272-4724. The examiner can normally be reached on Monday - Friday 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571)272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jonathan ML Foreman/
Examiner, Art Unit 3736